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Paper No. 19

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**SEP 22 2004**

**OFFICE OF PETITIONS**

In re Application of  
Jason Scott Sawyer et al  
Application No. 09/836,567  
Filed: April 17, 2001  
Attorney Docket No. 3051-67789

:  
:DECISION ON PETITION TO  
:REVIVE AND DECISION  
:REFUSING STATUS UNDER  
:37 CFR 1.47(a)

This is a decision on the petitions under 37 CFR 1.137(b) to revive the above-identified application and on the petition under 37 CFR 1.47(a) filed April 29, 2004.

The petitions are dismissed.

Any request for reconsideration must be submitted within TWO MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any reply should be entitled "Renewed Petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a)" and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the nonsigning inventor. This is **not** a final agency action within the meaning of 5 U.S.C. §704.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.17(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(c) and (D). The instant petition lacks item (1) since the application cannot be revived until such time as a grantable petition under 37 CFR 1.47(a) has been received.

The above-identified application was filed on April 17, 2001, with an unexecuted declaration naming Jason Scott Sawyer, Stephen M. Spaethe, and James Jacob Starling as the inventors.

On May 9, 2001, a Notice to File Missing Parts of Nonprovisional Application (Notice) was mailed setting a two month extendible period for supplying an executed oath or declaration, a \$130 surcharge fee for its late filing, and an abstract.

In reply, applicants, on July 9, 2001, supplied an abstract, and on July 30, 2001, submitted an executed declaration for inventors Jason Scott Sawyer, Stephen M. Spaethe, and James Jacob Starling. The July 30, 2001 declaration also named Gabriele Jedlitschky, Inka Leier, and Dietrich Keppler, whose signatures were not supplied at the time of filing. The \$130 surcharge fee was also received on July 30, 2001.

Thereafter, this application was processed as complete, despite the missing signatures of the above-named inventors, and sent to the Technology Center for prosecution where, after the mailing of a nonfinal and final Office action, the application was finally allowed on October 22, 2002. Although not of record to date, it appears that, rather than paying the issue fee, a Request for Continued Examination (RCE) was filed on January 28, 2003.

On July 14, 2003, a "Petition under 37 C.F.R. § 1.181" was filed to clarify the record regarding the inventorship and status of the application.

On February 24, 2004, the Director of Technology Center 1600 replied, stating that this application is abandoned for failure to supply the signatures of all six named inventors, as shown on the first submitted executed declaration of July 30, 2001, within the time period as required by the Notice of May 9, 2001. The decision further stated that, as the declaration was executed by three of the six named inventors, this set the inventive entity. Note 37 CFR 1.48(f).

On April 29, 2004, a petition to revive under 37 CFR 1.137(b) and a petition under 37 CFR 1.47(a) was filed setting forth the facts surrounding the attempts to obtain the signature on a declaration from the legal representative of deceased inventor Stephen M. Spaethe. The petition is also accompanied by a declaration naming inventors Jason Scott Sawyer, James Jacob Starling, and Stephen M. Spaethe, but only signed by the first two inventors as inventor Stephen M. Spaethe is now deceased.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) set forth above.

As to item (1), it is inconsistent for petitioner to seek Rule 47 status, where six inventors were named on the declaration but only three signed. **In this regard, petitioner must submit a petition under 37 CFR 1.48(a) to correct the inventive entity.** There is no indication to date that a petition under 37 CFR 1.48(a) has been submitted. Alternatively, petitioner may wish to file a continuing application with a request for deletion of the names of the inventors who are not the inventors. Note MPEP 201.03.

Further, as to the 37 CFR 1.47(a) showing, there is no indication that a copy of the instant application was ever given to legal representative Lisa Spaethe. Rule 47 applicant must demonstrate with documented evidence that the legal representative refuses to join in the application after having been presented with the application papers (specification, claims, drawings and oath or declaration). There is no indication in the present case whether legal representative Lisa Spaethe was presented with a copy of the complete application papers for the instant nonprovisional application. If Mrs. Spaethe was not presented with a copy of the application papers for the instant nonprovisional application, then Mrs. Spaethe could not attest that she has "reviewed and understands the application papers" and could not execute the declaration she was requested to sign. Did legal representative Lisa Spaethe receive a copy of the application papers? Unless petitioner can show that a copy of the application papers was presented to Mrs. Spaethe, then petitioner will have to mail a copy of the complete application papers (specification, claims and drawings) to the last known address of Mrs. Spaethe, return receipt requested. A cover letter of instructions should accompany the mailing of the application papers setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. **The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, telegram, etc.** See MPEP 409.03(d).

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration **by the party to whom the refusal was made**. Where there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the rule 47 applicant that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Further correspondence with respect to this matter should be addressed as follows:

**By mail:** Mail Stop PETITION  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

**By hand:** Customer Window located at:

U.S. Patent and Trademark Office  
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Crystal Plaza Two Lobby, Room 1B03  
Arlington, VA 22202

**By fax:** (703) 872-9306  
Attn: Office of Petitions

Telephone inquiries related to this decision should be directed to Wan Laymon at (703) 306-5685.<sup>1</sup>

*Frances Hicks*  
Frances Hicks  
Lead Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>1</sup> Effective September 27, 2004, the phone number will be 571-272-3220.